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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91185261
Party	Defendant N.V. Sumatra Tobacco Trading Company
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of application Serial Nos. 76/415,303 and 76/415,305 and Reg. No. 2,972,594

American Cigarette Company, Inc.

Opposer/Respondent,

v.

Opp. Nos. 91185261  
(Consolidated)<sup>1</sup>

N.V. Sumatra Tobacco Trading Co.

Applicant/Petitioner.

**PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO RE-SET  
DEADLINES AND MOTION FOR EXTENSION OF TIME TO RESPOND TO  
PETITIONER'S MOTION FOR SUMMARY JUDGMENT**

Petitioner N.V. Sumatra Tobacco Trading Co. ("NV Sumatra") opposes the motion filed by Respondent, American Cigarette Company Inc. ("ACC") seeking to re-set deadlines and to extend the time to respond to NV Sumatra's Motion for Summary Judgment.

The time requested by ACC to review and assess the pleadings and discovery materials in this matter is excessive under all the circumstances explained below. The Board's December 9, 2011 Order suspended all proceedings pending disposition of the motion for summary judgment pursuant to Trademark Rule 2.127(d). The only currently relevant issue is the very narrow issue raised in NV Sumatra's Motion for Summary Judgment – namely whether there was, in fact, a bona fide use in the ordinary course of trade in use of the UNION mark for cigarettes by ACC on or before February 4, 2005. The circumstances and the documentation and information pertinent to the issue all derive from ACC. Activities of NV Sumatra are not pertinent to the motion.

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<sup>1</sup> While ACC has filed its Motion in the Board file for Cancellation No. 92052621, NV Sumatra has filed this response in the Board file for the parent case of these consolidated proceedings, Opposition No. 91185261 consistent with the Board's August 12, 2010 order, and the Board's reminder to the parties in Footnote 1 of its March 2, 2012 Order.

Moreover, the relevant documentation produced by both sides in these consolidated proceedings has been extremely small. Of the 4,000 documents that have been produced, less than 200 were produced by NV Sumatra for review by ACC, with these documents consisting primarily of the file histories for the subject applications.<sup>2</sup> With respect to the documents produced by ACC, the vast majority of these documents were outside the time period pertinent to the motion for summary judgment leaving a very limited number of relevant documents – almost all of which were attached to NV Sumatra’s Motion for Summary Judgment as exhibits. Accordingly, NV Sumatra submits that 30 days from the date of ACC’s Notice of Appearance, calculated as May 2, 2012, should be more than sufficient time to review and assess the pleadings and discovery materials.

ACC’s request for tentative time to conduct additional discovery under Rule 56(f) is inappropriate for two reasons. First, a motion for leave to take discovery at this point would be untimely. Trademark Rule 2.127(e)(1) specifically states that a motion under Rule 56(f) of the Federal Rules of Civil Procedure, if filed in response to a motion for summary judgment, shall be filed within thirty days of the summary judgment motion (December 31, 2011 in this case). Rule 2.127(e)(1) goes on to say the time for filing a motion under Rule 56(f) will not be extended. ACC did not timely make a request under Rule 56(f), F.R.C.P. The fact that ACC sought and obtained an extension of time with N.V. Sumatra’s consent to actually respond to the summary judgment motion did not alter the obligation of filing the Rule 56(f) motion within 30 days. See TBMP Section 528.06.

Second, all information which would be pertinent for the Response to N.V. Sumatra’s Motion for Summary Judgment would be based on the documents and actions of ACC – information in the exclusive control of ACC. Moreover, the only affidavits produced in support of NV Sumatra’s Motion for Summary Judgment were those of (i) Osmar Souza Filho – an individual identified by ACC in its interrogatory responses; and (ii) counsel for NV Sumatra regarding the review of documents at government agencies, the authenticity of such documents, and documentation of prior conversations with ACC counsel. In any event, as noted above, any discovery in support of other possible motions/pleadings for the case which would be unrelated

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<sup>2</sup> The applications at issue remain intent-to-use based applications for which there is little relevant documentation.

to the summary judgment motion is not to be considered at this time per the Board 's previous suspension order.

Finally, the time requested by ACC to respond to NV Sumatra's Motion for Summary Judgment is excessive given the narrow scope of the relevant issue and supporting documentation associate with this summary judgment request. NV Sumatra filed its Motion for Summary Judgment with the Board over four months ago on December 1, 2011. The Motion was based on a very focused issue – again, whether there was a bona fide use of the UNION mark in the ordinary course of trade for cigarettes by ACC on or before February 4, 2005. In light of the narrow focus of the relevant inquiry, and the fact that all documentation and evidence relevant to responding to the issue would be in the exclusive control of ACC, NV Sumatra requests the Board to set the time to respond to the Motion for Summary Judgment as June 2, 2012. This timetable would provide ACC with more than 6 months from the date of the filing of the Summary Judgment Motion to respond – a length of time which should be more than sufficient. To this end, it also should be noted that the firm of counsel of record was retained by ACC as outside counsel on a different application of ACC nearly nine months ago. See Copy of Revocation and Appointment of Attorney dated June 6, 2011 filed in connection with ACC's AZTEC application (No. 77/568,712) attached as Exhibit A. Consequently, it cannot be reasonably concluded that ACC needed the extended time already taken to associate counsel for this proceeding.

NV Sumatra also wishes to bring to the attention of the Board that ACC has assigned the registration for UNION which is the subject of the NV Sumatra cancellation petition (Reg. No. 2,972,594) per the document recorded at Reel 4665, Frame 0479 on November 23, 2011. NV Sumatra learned of this assignment after it had filed its Motion for Summary Judgment. ACC has never given notice of this transfer to NV Sumatra and it is presumed ACC intends to see the proceedings through to a conclusion on its own (with the results being binding on the assignee). Counsel for NV Sumatra advised new counsel for ACC of this assignment in the phone conference referenced in ACC's motion for extension. NV Sumatra raises this now so that the assignment will not become the basis of some future motion to extend time to respond to the summary judgment motion.

Based on the foregoing, NV Sumatra requests the Board to reject the proposed deadlines offered by ACC and set the deadlines offered by NV Sumatra.

Respectfully submitted,

N.V. Sumatra Tobacco Trading Company

Date: April 5, 2012

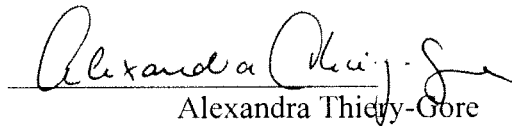
By: \_\_\_\_\_/tmv/\_\_\_\_\_  
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Attorneys for Applicant/Petitioner  
N.V. Sumatra Tobacco Trading Company

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO RE-SET DEADLINES AND MOTION FOR EXTENSION OF TIME TO RESPOND TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT was served via email on this 5<sup>th</sup> day of April 2012 upon the following:

Robert Angle Troutman Sanders 1001 Haxall Point Richmond VA 23219 Robert.angle@troutmansanders.com	Richard Rimes Troutman Sanders 600 Peachtree Street, NE Suite 5200 Atlanta, GA 30308-2216 Richard.rimer@troutmansanders.com trademarks@troutmansanders.com
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Alexandra Thiey-Gore

# **Exhibit A**

## Revocation of Attorney/Domestic Representative and/or Appointment of Attorney/Domestic Representative

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77568712
LAW OFFICE ASSIGNED	LAW OFFICE 113
ATTORNEY DOCKET NUMBER	240089.000001
MARK SECTION	
MARK	AZTEC
ATTORNEY SECTION	
ORIGINAL ADDRESS	Robert C. Kain, Jr. Kain & Associates, Attorneys at Law, P.A 6182-31 Suite 205 900 SE Third Avenue Ft. Lauderdale FL 33316 954-768-9002 ekotler@complexip.com
NEW OTHER APPOINTED ATTORNEYS	and Robert L. Brooke, Esq., members of the bar of the Commonwealth of Virginia; Michael D. Hobbs, Jr., Esq., Daniele E. Bourgeois, Esq., Edward M. Finnerty, Esq., Ryan A. Schneider, Esq., and James E. Schutz, Esq., members of the bar of the State of Georgia; James A. Thomas, Esq. a member of the bar of the States of Georgia and North Carolina; Sheldon R. Pontaoe, Esq., a member of the bar of the State of New Jersey; Karl M. Zielaznicki, Esq. and Eileen D. Pontaoe, Esq. members of the bar of the States of New York and New Jersey; and Bernard Pike, Esq., a member of the bar of the Commonwealths of Virginia and Pennsylvania.
NEW ATTORNEY ADDRESS	
STATEMENT TEXT	By submission of this request, the undersigned REVOKES the power of attorney currently of record, as listed above, and hereby APPOINTS the following new attorney.



<b>NAME</b>	Nancyellen Keane, Esq.
<b>FIRM NAME</b>	Troutman Sanders LLP
<b>INTERNAL ADDRESS</b>	Suite 5200, Bank of America Tower
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<b>CITY</b>	Atlanta
<b>STATE</b>	Georgia
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<b>PHONE</b>	804-697-1272
<b>FAX</b>	804-698-5140
<b>EMAIL</b>	trademarks@troutmansanders.com
<b>ATTORNEY AUTHORIZED TO COMMUNICATE VIA E-MAIL</b>	YES
<b>ATTORNEY DOCKET NUMBER</b>	240089.000001

#### NEW CORRESPONDENCE ADDRESS

<b>NAME</b>	Nancyellen Keane, Esq.
<b>FIRM NAME</b>	Troutman Sanders LLP
<b>INTERNAL ADDRESS</b>	Suite 5200, Bank of America Tower
<b>STREET</b>	600 Peachtree Street, NE
<b>CITY</b>	Atlanta
<b>STATE</b>	Georgia
<b>COUNTRY</b>	United States
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<b>PHONE</b>	804-697-1272
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<b>EMAIL</b>	trademarks@troutmansanders.com
<b>AUTHORIZED TO</b>	

<b>COMMUNICATE VIA E-MAIL</b>	YES
<b>OTHER APPOINTED ATTORNEY</b>	and Robert L. Brooke, Esq., members of the bar of the Commonwealth of Virginia; Michael D. Hobbs, Jr., Esq., Daniele E. Bourgeois, Esq., Edward M. Finnerty, Esq., Ryan A. Schneider, Esq., and James E. Schutz, Esq., members of the bar of the State of Georgia; James A. Thomas, Esq. a member of the bar of the States of Georgia and North Carolina; Sheldon R. Pontaoe, Esq., a member of the bar of the State of New Jersey; Karl M. Zielaznicki, Esq. and Eileen D. Pontaoe, Esq. members of the bar of the States of New York and New Jersey; and Bernard Pike, Esq., a member of the bar of the Commonwealths of Virginia and Pennsylvania.

## SIGNATURE SECTION

### SIGNATORY FILE

<b>ORIGINAL PDF FILE</b>	<u>hw 722421971-182910869 . Untitled .pdf</u>
<b>CONVERTED PDF FILE(S) (1 page)</b>	<u>\\TICRS\EXPORT1\IMAGEOUT1\775\687\77568712\xml9\RAA0002.JPG</u>
<b>SIGNATORY NAME</b>	/Basil Battah/
<b>SIGNATORY POSITION</b>	President

## FILING INFORMATION SECTION

<b>SUBMIT DATE</b>	Mon Jun 06 18:47:43 EDT 2011
<b>TEAS STAMP</b>	USPTO/RAA-72.242.197.1-20 110606184743206012-775687 12-4806daf82b317bdb01afcc fd0fb91f812e2-N/A-N/A-201 10606182910869911

## **Revocation of Attorney/Domestic Representative and/or Appointment of Attorney/Domestic Representative**

To the Commissioner for Trademarks:

**MARK:** AZTEC

**SERIAL NUMBER:** 77568712

**ATTORNEY DOCKET NUMBER** 240089.000001

**The original attorney**

Robert C. Kain, Jr.

Kain & Associates, Attorneys at Law, P.A.

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954-768-9002

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By submission of this request, the undersigned REVOKES the power of attorney currently of record, as listed above, and hereby APPOINTS the following new attorney. In addition, any additional previously-appointed attorneys that are currently listed in the application are replaced with the new "Other Appointed Attorneys" listed below.

**Newly Appointed Attorney:**

Nancyellen Keane, Esq.

Troutman Sanders LLP

Suite 5200, Bank of America Tower

600 Peachtree Street, NE

Atlanta, Georgia 30308-2216

United States

804-697-1272

804-698-5140

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240089.000001

**Other Appointed Attorneys:**

and Robert L. Brooke, Esq., members of the bar of the Commonwealth of Virginia; Michael D. Hobbs, Jr., Esq., Daniele E. Bourgeois, Esq., Edward M. Finnerty, Esq., Ryan A. Schneider, Esq., and James E. Schutz, Esq., members of the bar of the State of Georgia; James A. Thomas, Esq. a member of the bar of the States of Georgia and North Carolina; Sheldon R. Pontaoe, Esq., a member of the bar of the State of New Jersey; Karl M. Zielaznicki, Esq. and Eileen D. Pontaoe, Esq. members of the bar of the States of New York and New Jersey; and Bernard Pike, Esq., a member of the bar of the Commonwealths of Virginia and Pennsylvania.

**The following is to be used as the correspondence address:**

Nancyellen Keane, Esq.  
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United States

804-697-1272

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trademarks@troutmansanders.com The attorney docket/reference number is 240089.000001.

**Original PDF file:**

hw\_722421971-182910869 . Untitled .pdf

**Converted PDF file(s) (1 page)**

Signature File1

Signatory's Name: /Basil Battah/

Signatory's Position: President

Serial Number: 77568712

Internet Transmission Date: Mon Jun 06 18:47:43 EDT 2011

TEAS Stamp: USPTO/RAA-72.242.197.1-20110606184743206

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91f812e2-N/A-N/A-20110606182910869911

**Revocation of Attorney/Domestic Representative and/or Appointment of  
Attorney/Domestic Representative**

**Handwritten Signature**

Signature Section:

Signature: 

Date: 5/17/2011

Signatory's Name: Basil Battah

Signatory's Position: President

**NOTE TO APPLICANT:** When filed as part of the electronic form (i.e., scanned and attached as an image file), include only the signature page (no declaration is required, nor should any other information from the actual revocation be included).

